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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,416	12/20/1999	PIETER DE HAAN	0/97286US	2292

31846 7590 06/30/2004

AKZO NOBEL PHARMA PATENT DEPARTMENT  
29160 INTERVET LANE  
MILLSBORO, DE 19966

EXAMINER
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DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/446,416

Applicant(s)

HAAN ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

OP

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by J. Muir (USPN 1655158).

Muir discloses a preloadable implantation device comprising a needle, and an elongated part, a plunger, the periphery of the plunger defining a channel, and a chamber. (Figures 1-10 and entire reference)

Wherein the needle is chamfered. (Figures 4-9)

Wherein the outside is closed after preloading. (Figures 4-8)

3. Claims 1, 3-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wiegerinck (USPN 5,405,324).

Wiegerinck discloses a preloadable implantation device comprising a needle, and an elongated part, a plunger, the periphery of the plunger defining a channel, and a chamber. (Figures 1-3 and entire reference)

Wherein the needle and plunger are chamfered. (Figures 1-3)

Wherein the outside is closed after preloading. (Figures 1-3)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir as applied to claims 1, 3, 5, 7, 8 above, and further in view of Wiegerinck.

Muir discloses the claimed invention but fails to disclose the implant is a hormonal implant.

Wiegerinck (USPN 5405324) discloses the implant as a hormonal implant.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Muir with Wiegerinck because it is well known in the medical art to use different types of medication with different types of applications, such as using hormonal pills or tablets, as stated in Wiegerinck. (Column 1, lines 1-25)

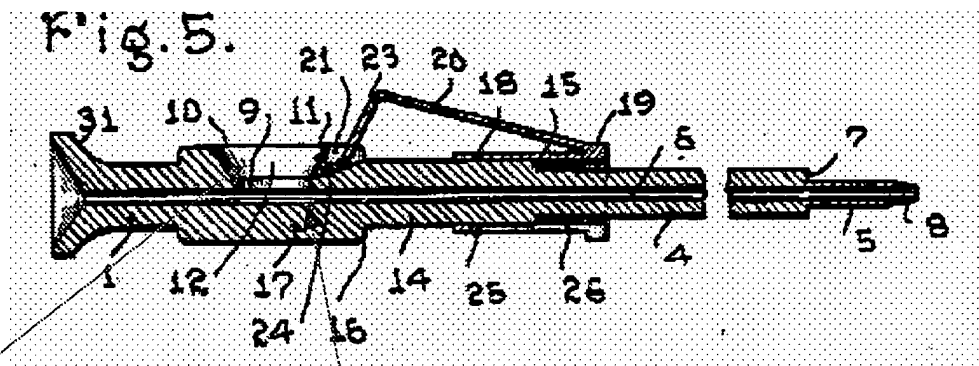
Therefore, it would have been obvious to combine the teachings of Muir with Wiegerinck to obtain the invention as specified in claims 1, 3-9.

***Response to Arguments***

6. Applicant's arguments filed 3/26/04 have been fully considered but they are not persuasive with regards to Muir and Wiegerinck. Upon further evaluation the examiner withdraws the rejection based on '613.

Art Unit: 3763

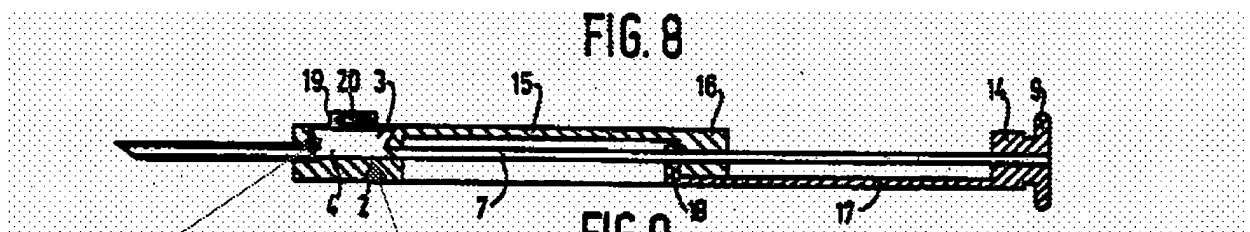
With regard to Muir, the examiner disagrees with the applicant and has pasted the pictures of the prior art to show the claimed features. The examiner shows the limitations that the applicant is arguing below.



This is the chamber that is located above the channel.

This is the channel that is within the elongated part and the needle. Reference number to the channel is 6.

With regards to Wiegerinck, the examiner disagrees with the applicant and has pasted the pictures of the prior art to show the claimed features. The examiner shows the limitations that the applicant is arguing below.



This is the chamber that is located above the channel.

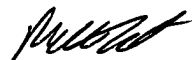
This is the channel that is within the elongated part and the needle. Reference number to the channel is 6.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto  
Art Unit 3763  
June 23, 2004



LOAN H. THANH  
PRIMARY EXAMINER